

## **REMARKS**

This amendment is responsive to the Office Action dated June 4, 2007. Previous to the Office Action, a Notice of Allowance was issued in this case. Following a withdrawal of the Notice of Allowance, the Office Action rejected all pending claims under 35 U.S.C. §103 as being obvious over U.S. Patent No. 4,408,761 to McAllister in view of U.S. Patent No. 5,709,385 to Fitzpatrick et al. Applicant has carefully reviewed the arguments presented therein, and respectfully request reconsideration of the pending claims in view of the remarks presented below.

### **McAllister**

U. S. Patent No. 4,408,761 to McAllister discloses a board game played on a "table" or "board" covered with green baize "marked out like a football pitch." Players use a cue to move pieces that roll on the board, and the game appears to be intended to simulate soccer using a board game. The game includes "corner pieces 41 which limit the playing area at the corners ...", which would be necessary because the ball could become trapped in a corner to the point where a player could not use the cue to maneuver the player piece so as to

### **Fitzpatrick et al**

U.S. Patent No. 5,709,385 to Fitzpatrick et al. discloses a board game in which game pieces are flicked on the board using a player's finger. Although the Office Action fails to identify which structure it is referring to, the Applicant assumes that when the Office Action states "Fitzpatrick et al. disclosed a sports rink having first and second red zone as recited in claim 1" the Office Action is referring to the simulated three point line shown in figure 15 of that disclosure.

## **The Claimed Invention**

The invention is recited as a "sports rink," which the specification describes is for "speed hockey" game in which actual skaters move about on a playing surface. Numerous references in the specification help to define "rink" as a playing surface for the speed hockey game set forth therein. Webster's Dictionary defines rink as:

"a smooth extent of ice marked off for curling or ice hockey b. a surface of ice for ice skating; also: a building containing such a rink c: an enclosure for roller-skating ...."

Applicant respectfully traverses the Office Action's assertion that either McAllister or Fitzpatrick discloses the claimed "rink" because both McAllister and Fitzpatrick teach only board games. McAllister has a board for accommodating game pieces and Fitzpatrick has a board used to mark spots for flicking coins or the like. It is submitted that the combination of McAllister and Fitzpatrick, even if appropriate, could at most be reasonably be construed to teach another board game but in no way could they in any way be reasonably read to teach a skating rink adopted for rules that are in no way similar to either of the cited references. Accordingly, Applicant requests that the rejection be withdrawn and the claims be returned to their condition before the most recent.

The first feature of Claim 1 is that the length and width of the rink are equal. The Office Action does not acknowledge this claimed feature, and neither the cited references teach this feature. Rather, both can be said to teach away from this claimed feature by adopting a traditional soccer pitch shape in the case of McAllister and a basketball court shape in the case of Fitzpatrick. If the examiner maintains his rejection of the claims, Applicant respectfully requests that the examiner issue a non-final office action addressing all of the claim limitations so that Applicant can set forth arguments in response thereto.

Claim 1 further calls for a semi-circular red zone to extend to the center circle. Again, this feature is not taught nor suggested by the cited art, and is not address by the Office Action. Since all of the claimed features must be taught or suggested by the art in a *prima facie* case of obviousness, Applicant respectfully submits that the Office Action has failed to establish the required *prima facie* case and that the rejection of Claim 1 is improper. If the examiner believes that Claim 1 is obvious over the cited art, Applicant respectfully requests that a non-final Office Action be issued specifically addressing the issue raised above.

Claim 1 further calls for first and second semi-circular red zones centered on the first and second goals. McAllister, which is a soccer game, shows only a goal crease or goalie box used to designate the area in which the goalie can maneuver (See discussion in Column 3 on "Goal Area"). Recognizing that McAllister fails to teach the required first and second semi-circular red zones, the Office Action cites to Fitzpatrick which shows two different three point lines representing a professional and collegiate three point shooting lines found in some arenas. Which discussing the obvious incongruity in combining basketball lines with a soccer field, the Office Action merely recites without any explanation that it would have been obvious to combine the two references, noting only that it would allow "the players [to] earn different points at different red zones." [Office Action, p. 2]. Since that is completely contrary to the rules of soccer, Applicant questions why such a drastic rule change heretofore unheard of in any soccer game of which the Applicant is aware of is obvious to the examiner. Certainly there is no teaching in either reference that would support this modification or even suggest that it would be beneficial make the proposed combination (since most soccer fans who would be interested in the board game of McAllister would likely be dismayed that the rules of soccer are not being followed.

Rule 706.02(j) of the MPEP sets forth the three criteria that the PTO must establish in every case for rejecting a claim under 35 U.S.C. §103. Included in that provision is the need to establish some motivation to make the proposed combination as

suggested by the Office Action, since most if not all inventions are combinations of known elements. Without this requirement to show a motivation that is so prevalent and clear as to render the considered invention "obvious," certainly no patents would issue because all that would be required is that the examiner simply locate individual features of various prior art, regardless of their applicability to one another, and then simply argue that the proposed combination would have been obvious. That is exactly what the Office Action has attempted here, foregoing the rules and objects of the very prior art it seeks to combine. Applicant submits that this approach is not only contrary to the rules the Patent Office uses to assess patentability, but also has been widely condemned by the Federal Circuit Court of Appeals in many cases including *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002) and *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051 (Fed. Cir. 1988).

Applicant has demonstrated that the claimed invention is patentable over the art of record, and early notification of same is respectfully requested. If the examiner maintains his rejection, Applicant respectfully requests that a non-final Office Action be issued addressing all claim limitations as required by the MPEP, and that the Office Action provide evidence of a suggested benefit and motivation to combine the references as suggested by the Office Action that would not be contrary to the objects and rules of the very references sought to be combined.

Respectfully submitted,  
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